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| 09/804,819 | 03/13/2001 | Robert David Piotrowski | 7984 | 2044 |

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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EXAMINER

CARTER, MONICA SMITH

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| ART UNIT | PAPER NUMBER |
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3722

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 09/804,819
Filing Date: March 13, 2001
Appellant(s): PIOTROWSKI ET AL.

S. Robert Chuey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 3, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,568,763

KUNZLER

10-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims merely manipulate an abstract idea without producing a “useful, concrete and tangible result”. An abstract idea by itself never satisfies the requirements of 35 U.S.C. 101. In the present claims, the method for directing a consumer to one or more types of coffee from a plurality of options does not provide a “useful, concrete and tangible result” as required. There is no guarantee that any of the claimed Self-Characterization Cues would direct a consumer to one or more types of coffees. While the claimed invention does meet the requirements of 35 U.S.C. 101 with regards to being “useful” and “tangible”, the requirement of being “concrete” has not been satisfied. There is no clear, cut and “concrete” evidence that applicant’s claimed invention will perform as claimed.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunzler ('763).

Kunzler discloses a method of controlling an automatic coffee machine (9) wherein the automatic coffee machine has a plurality of selectors (1-7) for indicating desired parameters such as the size of coffee desired and the type of coffee desired (e.g. decaffeinated). Kunzler discloses that "this allocation is only an example, and that it may be fashioned for other types of coffee and other beverages, such as hot chocolate, hot water for tea, etc." (see col. 3, lines 30-43). Inherently, the type of beverage to be used in the machine would determine the particular indicia provided on the selectors (which could be presented in any format as desired by the end user, to include a guide/chart and/or modified slide rule). In figure 1, the seven selectors located on the front operating side (8) of the machine (9) provide a guide/chart (see col. 2, lines 24-28 and col. 3, lines 30-31).

(11) Response to Argument

Appellant traverses the 35 U.S.C. §101 rejections of the claims which state that the requirement of the claimed invention being "concrete" has not been satisfied. Appellant alleges that the present claims define a method that produces a "useful, concrete, and tangible result", which is, the consumer purchases a

coffee product that is best suited to their lifestyle and tastes. As stated in the above rejections, the present claims fail to meet all of the requirements of 35 U.S.C. §101. The claims must provide a “useful, concrete and tangible result”. As stated above, the claims fail to provide a “concrete” result since there is no guarantee or assurance that the claimed Multiple Self-Characterization Cues will, in fact, direct a consumer to one or more types of coffee. There are many factors that help a consumer to determine what type of coffee to select (e.g., taste preference, health related concerns, social environment/climate, etc.). It cannot be conclusively determined that the particular Cues as set forth by appellant, will direct a consumer to purchase a particular type of coffee. The result of appellant’s claimed invention is speculative and it would require undue experimentation to produce the concrete result. The claims merely manipulate an abstract idea of coffee selection without producing a “useful, concrete and tangible result”.

Appellant argues that the selection and purchase of coffee is the “concrete” result. The examiner respectfully agrees that the ultimate purchase of coffee provides a “concrete” result; however, the examiner maintains that it cannot be conclusively determined that, in light of appellant’s claimed method using the Multiple Self-Characterization Cues, the consumer purchases the coffee based upon the cues set forth by the present invention. It is conceivable that the consumer has a predilection for a particular type of coffee and despite the presence of the Multiple Self-

Characterization Cues as set forth by appellant, the consumer would purchase the coffee of his/her choosing based upon his/her prior purchases.

The examiner, therefore, maintains that the presently claimed invention fails to meet the requirements of 35 U.S.C. 101.

Appellant argues that Kunzler fails to disclose varying the type of coffee selected by a consumer. Appellant further states that Kunzler teaches a standard coffee brewer wherein the strength and quantity of the coffee is varied based on a consumer's selected criteria. Kunzler discloses a method of controlling an automatic coffee machine 9 wherein the automatic coffee machine has a plurality of selectors 1-7 for indicating desired parameters such as the size of coffee desired and the type of coffee desired (e.g. decaffeinated). As seen in figure 1, the seven selectors located on the front operating side of the machine carry icons in the shape of varying sized coffee cups to provide the user with a quick guide for selecting the desired coffee. While Kunzler does disclose varying the quantity of the coffee selected (as set forth in col. 3, lines 30-43) using the selectors, Kunzler also discloses that "this allocation is only an example, and that it may be fashioned for other types of coffee and other beverages, such as hot chocolate, hot water for tea, etc." Inherently, these other types of coffee could include parameters that vary the roast, grind, flavor, country of origin, etc., depending on the result desired and the information to be conveyed by the manufacturer of the coffee machine. The examiner maintains that Kunzler does disclose the presently claimed invention of directing a consumer to one or more types of coffee

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from a plurality of options using selectors (cues) for the reasons as previously stated above.

For the above reasons, it is believed that the rejections should be sustained.

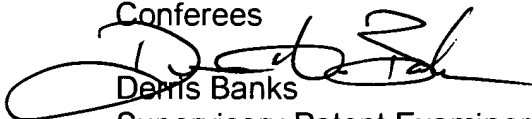
Respectfully submitted,



Monica S. Carter
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September 5, 2003

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